

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Nathanael F. Ehrich, et al.

December 20, 2006

Serial No.: 10/674,769

Filed: September 30, 2003

For: Providing Scalable, Alternative Component-Level Views

Art Unit: 2178

Examiner: Thu V. Huynh

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
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Sir:

This is an Appeal seeking reversal of the decision of the Primary Examiner, finally rejecting all current claims of the subject patent application.

1) REAL PARTY IN INTEREST

The real party in interest is the Assignee, International Business Machines Corporation (“IBM”).

2) RELATED APPEALS AND INTERFERENCES

Appellants, the Appellants’ legal representative, and the assignee, have no personal knowledge of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

3) STATUS OF CLAIMS

Claims 1 - 5 and 7 - 19 stand rejected. Claim 6 has been cancelled from the application without prejudice. Claims 1 - 4, 7 - 14, and 16 - 19 are under appeal.

4) STATUS OF AMENDMENTS

No Amendments were filed after receiving the Final Rejection mailed on April 20, 2006.

5) SUMMARY OF CLAIMED SUBJECT MATTER

1. Appellants’ independent Claim 1 is directed toward selecting component-level views (Claim 1, line 1) of content, and specifies “a content file comprising a template for the requested content” (Claim 1, line 4), where this template “specifies a plurality of alternative selectable views of a component that forms a portion of the content ...” (Claim 1, lines 5 - 6). See **Fig. 1**, illustrating a content file **100** comprising a template **110**, where template **110** specifies a plurality of alternative selectable views **120**, **130**, and **140**. See also Specification, p. 14, lines 4 - 6 and

lines 9 - 14. Claim 1 further specifies “evaluating ... factors to determine an evaluation result” (Claim 1, line 7; Specification, p. 15, lines 3 - 4; p. 25, lines 1 - 10), and “using the determined evaluation result to select a particular one of the ... alternative selectable views” (Claim 1, lines 9 - 10; Specification, p. 25, lines 11 - 18). See also **112** of **Fig. 1**, identifying a “subscription” type value that indicates which factors are used to select among the views **120**, **130**, **140** in the sample template **110**, and the values of the “name” attribute on each of the 3 selectable views (i.e., “basic”, “intermediate”, and “premium”, in this example, representing 3 different subscription levels). Claim 1 further specifies “using the particular one of the ... alternative views, within the content file, for the portion of the content” (Claim 1, lines 11 - 12, emphasis added). Specification, p. 26, lines 8 - 9.

2. **Figs. 2A** and **2B** provide an example that corresponds to the content file **100** and template **110** of **Fig. 1**, using a sample traffic report Web page where a first alternative view “As of 12:30 p.m. ...” and a second alterative view “(Image of traffic ...)”, respectively, are illustrated therein as the content portion beneath the header “My Traffic Report”. See also **300** of **Fig. 3**, illustrating markup language corresponding to document **200** of **Fig. 2A**, and reference number **310**, where the first alternative view **120** from **Fig. 1** has been selected as the “particular one” (Claim 1, lines 9 - 10), and has been “us[ed] .. within the content file, for the portion of the content” (Claim 1, lines 11 - 12). That is, text obtained using the “value” attribute specified at **125** in **Fig. 1** (e.g., by accessing a text file named “trafficLocationXYZ.txt”) has been used in place of the template **110**.

3. In this manner, varying content can be dynamically generated – such as the 3 different

versions of content file **100** that are possible by selecting different ones of the alternative views **120, 130, 140** – even though multiple versions of that content do not need to be manually created (Specification, p. 14, lines 2 - 8; see also p. 10, lines 9 - 18). Accordingly, administrative burden on IT professionals is reduced, as compared to prior art approaches of using a separate markup-language file for each alternative view (Specification, p. 17, line 18 - p. 18, line 11).

4. Independent Claim 18 specifies similar limitations, and further specifies that the template specifies “an associated selection identifier” for each view (Claim 18, lines 7 - 8; see the “name= ...” attribute on each of the selectable views **120, 130, 140** of **Fig. 1**) and “mapping the ... evaluation result to a particular one of the specified selection identifiers” (Claim 18, lines 11 - 12). In other words, the evaluation result might be expressed differently than the values of the name attributes, requiring a mapping therebetween (Specification, p. 15, lines 4 - 5; p. 26, lines 2 - 7). So, for example, the evaluation result might be “low”, and this might be mapped to the name attribute value of “basic”. Claim 18 further specifies “using ... the selected alternative view ... in place of the specified plurality of alternative selectable views ...” (Claim 18, lines 14 - 16, emphasis added). See **Fig. 3**, where the selected view **120** is used at **310, in place of** template **110** from **Fig. 1**, to thereby yield document **300**.

5. Dependent Claim 11 is argued separately, and with regard to Claim 1 from which it depends, further specifies that the “using” step comprises “substituting the selected alternative view, within the content file, for the specification of the plurality of alternative selectable views and conditions”. See **Fig. 3**, where the selected view **120** is substituted (see **310**) for template

110 from **Fig. 1** (where the template comprises the “specification of the plurality ...”; Claim 1, lines 4 - 6) to thereby yield document **300**.

6. Independent Claim 13 is directed toward generating content using alternative component-level views (Claim 13, lines 1 - 2; Specification, p. 11, lines 17 - 19), and specifies that a template “is contained within a content file” and “specifies a plurality of alternative selectable views ...” (Claim 13, lines 3 - 7), as discussed above in paragraphs 1 and 4. Claim 13 further specifies “evaluating ... factors” (Claim 13, lines 8 - 9) and “mapping the ... evaluation result to a particular one of the specified selection identifiers, thereby selecting the associated one of the specified alternative selectable views” (Claim 13, lines 10 - 11), as discussed above in paragraphs 1 and 4. Claim 13 further specifies “using, when generating a version of the content, the selected alternative view of the component (Claim 13, lines 12 - 13). See **Fig. 3**, where the selected view **120** is used (see **310**) when generating the version **300** of the content according to template **110** from **Fig. 1**.

7. Independent Claim 19 specifies similar limitations, but instead of specifying a “mapping” limitation, specifies “... using the determined evaluation result to select a particular one of the specified alternative selectable views” (Claim 19, lines 11 - 12), as discussed above in paragraph 1. Claim 19 further specifies “... using the particular one ... within the content file in place of the specification ... [i.e., in place of the template]” (Claim 19, lines 13 - 15, emphasis added). See **Fig. 3**, where the selected view **120** is used (see **310**) in place of template **110** from **Fig. 1** (where the template comprises the “specification of the alternative selectable views and the conditions”;

Claim 19, lines 5 - 7) to thereby yield document **300**.

8. Dependent Claims 16 and 17 are argued separately. With regard to Claim 13 from which they depend, Claim 16 further specifies that the “using” step comprises “embedding the selected alternative view ... in place of the [template]” (Claim 16, emphasis added), and Claim 17 further specifies that the “using” step comprises “embedding an identifier of the selected alternative view ... in place of the [template]” (Claim 17, emphasis added). So, whereas the example syntax **125** in view **120** of **Fig. 1** identifies a text file containing the content view which is embedded at **310** in **Fig. 3** (and illustrated beneath the header within **Fig. 2A**), according to Claim 16, the language of Claim 17 corresponds to the example syntax **135, 145** of **Fig. 1**, where a URL would be embedded into the content file in place of the template (and, upon invocation of the URL, would retrieve a JPEG or MPEG file, respectively, in the example). This URL approach is discussed on p. 20, lines 4 - 8 of Appellants’ Specification (“a ... “URL” has been used for identifying the locations ... the specified URL is preferably embedded in the response document ...”).

9. Independent Claim 18 includes means plus function terminology. Structure, material, or acts supporting this terminology are described in Appellants’ specification, as will now be described.

10. With regard to the “means for receiving” element of independent Claim 18, see p. 1, lines 9 - 11 (referring to client/server computing); p. 10, lines 13 - 14; and p. 24, lines 15 - 16. See also p. 2, lines 2 - 10 and p. 3, lines 1 - 3. For the “means for locating a content file” element of

Claim 18, see p. 14, lines 9 - 14 and **Fig. 1**. The “means for evaluating” element is discussed on p. 11, line 17 - p. 12, line 4; p. 13, lines 6 - 12; p. 24, lines 8 - 12; p. 25, lines 1 - 10; and p. 27, lines 12 - 17. The “means for mapping” element is discussed at p. 26, lines 2 - 7. The “using” limitation is discussed on p. 26, lines 8 - 11. In a general sense, see also the discussion on p. 28, line 13 - p. 30, line 1, discussing implementation using hardware, software, a combination of hardware and software, a computer program product embodied on computer-readable storage, etc.

6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

11. The first ground of rejection presented for review is a rejection of Claims 1 - 4, 7 - 12, and 18 under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,457,030 to Adams et al. (hereinafter, “Adams”) in view of U. S. Patent Application 2002/0122054 to Hind et al. (hereinafter, “Hind”).

12. The second ground of rejection presented for review is a rejection of Claims 13 - 14, 16 - 17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Adams in view of Hind and further in view of U. S. Patent 6,966,034 to Narin.

7) ARGUMENT

7.1) First Ground of Rejection

13. Paragraph 7 of the Office Action dated April 20, 2006 (hereinafter, “the Office Action”) states that Claims 1 - 4, 6 - 12 (which should state “7 - 12”, as Claim 6 was previously cancelled),

and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Adams in view of Hind. Of these claims, the independent claims are 1 and 18.

14. Appellants respectfully submit that a *prima facie* case of obviousness under 35 U.S.C. §103 has not been made out as to these claims. Section 706.02(j) of the MPEP, “Contents of a 35 U.S.C. 103 Rejection”, states the requirements for establishing a *prima facie* case of obviousness under this statute, noting that three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach or suggest all the claim limitations. The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, “Legal Concept of *Prima Facie* Obviousness”, and MPEP §2143, “Basic Requirements of a *Prima Facie* Case of Obviousness”.

15. Furthermore, Appellants are entitled to have all words of the claimed invention considered when determining patentability. See Section 2143.03 of the MPEP, “All Claim Limitations Must Be Taught or Suggested”, referencing *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added).

7.1.1) Rejection of Independent Claims 1 and 18

16. With reference to independent Claim 1, Appellants respectfully note that this claim

explicitly specifies that the content file comprises a template (Claim 1, line 4) and that this template “specifies a plurality of alternative selectable views ...” (Claim 1, lines 5 - 6). In other words, the template is contained within the content file. Lines 11 - 12 of Claim 1 further specify that the particular (i.e., selected) one of the views is used, within the content file – i.e., within the same file that originally contains the template (and the other, non-selected, alternative selectable views specified by the template) – for the portion of content for which the selectable views are specified. With reference to **Fig. 1** and **Fig. 3**, the “content file” described by lines 4 - 6 of Claim 1 (i.e., the content file in which a template is specified) corresponds to **100 of Fig. 1** and the content file in which the “particular one of the specified alternative views” is used, as described by lines 11 - 12 of Claim 1, is exemplified at **300 of Fig. 3**. In particular, the “using” element from lines 11 - 12 of Claim 1 is illustrated by **310 of Fig. 3**, where this syntax at **310** replaces all of the template syntax at **110 of Fig. 1** to thereby yield document **300**.

17. In other words, one of the alternatives that is already present within the content file is selected, and this selected alternative is used for the portion of content (thus enabling the portion of the content to vary, according to which alternative view is selected).

18. Page 4, line 16 of the Office Action admits that Adams “does not explicitly disclose the template is within the content source”. Applicants respectfully submit that, in fact, Adams explicitly teaches that the template is not within the content file. See **Fig. 5A** of Adams, where a source file specifies a link to an external file using the <link href=“http//foo.com/catalog.meta”> syntax on the third line thereof. It is this separately-stored, external file (i.e., the

file referenced by the <link> element) that specifies the alternatives when using the technique of Adams. See **Fig. 5B**, where reference number **41a** identifies choices **44a, 44b, 44c** that may be used in place of reference number **30** of the separately-stored file in **Fig. 5A**. This is stated in col. 10, lines 11 - 12, “Three alternative images **44a, 44b, 44c** [of **Fig. 5B**] are available for replacing image **30** in the HTML file **6**’ of **Fig. 5A**. Thus, in contrast to Appellants’ claimed technique, Adams does not select an alternative that is already present within the content file, but instead selects an alternative from a separately-stored, external file.

19. Similarly, reference number **41b** of Adams’ **Fig. 5B** identifies choices **46a, 46b, 46c** that may be used in place of reference number **32** of the separately-stored file in **Fig. 5A**. This is stated in col. 10, lines 20 - 22.

20. Adams refers to the separately-stored, external file exemplified by **Fig. 5B** as a “content modification file” or “metafile” (col. 5, lines 61 - 63), and states that this file “contains information about modifying elements within the HTML file” to which the content modification file is linked. (Or, in another approach, the explicit link is not placed in the HTML file, and instead, the linkage between a content modification file and the HTML file to be modified is determined by hashing; see col. 6, lines 3 - 19.)

21. Note, in particular, that the text in col. 5, lines 59 - 63 states that “the HTML file is analyzed to identify a link to a content modification file” (emphasis added). In addition, the content modification file is shown as having a link back to the HTML file. See reference number

42 of **Fig. 5B** and the corresponding text in col. 10, lines 2 - 4. Thus, it is clear that Adams contemplates using two separate files.

22. See also **Fig. 2** of Adams, where content modification files (such as those of **Fig. 5B**) are illustrated at reference number **10** and separately-stored HTML files to be modified (such as those of **Fig. 5A**) are illustrated at reference number **6**. Col. 7, lines 39 - 43 discuss HTML file **6**, and col. 8, lines 5 - 12 state that “information contained within the content modification file **10**” is used to modify an HTML file **6**.

23. Furthermore, Appellants respectfully submit that Adams teaches away from their claimed approach of specifying a template within a content file for which the template specifies selectable alternative views. See col. 3, lines 5 - 18, where lines 5 - 10 state that “annotations”, such as “tags and/or attributes”, could be placed within an HTML file to “specify how portions of the HTML file are to be ... transformed ...”; col. 3, lines 10 - 14 then explain that such annotations “could require the addition and acceptance thereof” to the existing HTML standard, which “may be a difficult and time consuming task”. Lines 15 - 18 continue by stating that “even if it is possible to incorporate new tags and/or attributes within the current HTML standard, existing Web browsers may not be capable of handling these new tags and attributes”. As the Federal Circuit stated in *In re Geisler*, 43 USPQ 2d 1362, 1365 (Fed. Cir. 1997),

the Court of Customs and Patent Appeals stated that a *prima facie* case of obviousness can be rebutted if the applicant ... can show “that the art in any material respect taught away” from the claimed invention.

24. By contrast to the discussion in col. 3, lines 5 - 18 of Adams, Appellants have defined an approach whereby (non-standardized) tags and attributes are specified within the content file (Claim 1, lines 4 - 6, as illustrated by **110 of Fig. 1**), and the selected view – as selected from the plurality of views specified by those tags and attributes – is then used instead of the tags and attributes (Claim 1, lines 11 - 12, as illustrated by **310 of Fig. 3**). Accordingly, no change to the existing HTML standard is required, and existing Web browsers need not be concerned with handling the (non-standardized) tags and attributes.

25. Appellants therefore respectfully submit that their claimed approach is patentably distinct from, and is not rendered obvious by, the two-file, linking approach of Adams. As noted above in paragraph 18, the Office Action admits that Adams does not use a single file; see also p. 4, lines 13 - 15 of the Office Action, stating that Adams uses a template file [for example, **Fig. 5B**] that is “referred [to] from the content source [i.e., from **Fig. 5A**] through a reference link”.

26. Page 4, lines 17 - 19 of the Office Action then cite Hind, referring in particular to **Figs. 3** and **7**, as well as paras. **[0073]** and **[0074]** thereof. Page 4, line 20 - p. 5, line 2 of the Office Action then states that it would have been obvious to combine Hind with Adams “to include in-line content besides reference link, since the combination would have provided many implementations as Hind disclosed”. In other words, the Office Action asserts that it would have been obvious to put the alternatives illustrated by **Fig. 5B** of Adams into the HTML file in **Fig. 5A** of Adams (“include in-line content besides [just using a] reference link”). In response, Appellants respectfully submit that – as discussed above in paragraphs 23 - 24 – Adams explicitly

specifies reasons for not combining syntax from the two separate, linked files into a single file in this manner.

27. Furthermore, there is no syntax within **Fig. 3** or **Fig. 7** of Hind that specifies “a plurality of alternative selectable views”, and thus Hind’s teachings cannot be aligned to Appellants’ claim language. Instead, what is included “in-line” within **Fig. 3** is two separate transformations **330**, **350** – neither of which are alternatives to one another. In addition, none of the child tags within those transformations specifies things that are alternatives. (The syntax at reference numbers **336** - **339**, for example, specifies parameters used when invoking the JavaBean “test.class” that is named at reference number **334**.) With reference to **Fig. 7**, the syntax at **720** specifies a URL link to a separately-stored, external file from which a “TFC” (“transformation flow container”) can be retrieved. This format for referencing, or linking, a TFC may be used instead of the “in-line” format shown at **320** of **Fig. 3**.

28. See also **Fig. 6** of Hind, illustrating a sequential flow model where the first transformation **330** from **Fig. 3** is processed at **611**, and the second transformation **350** from **Fig. 3** is processed at **613**. (As one alternative, a parallel processing model may be used, as illustrated by **Fig. 10**, but the transformations are not alternatives to one another in this parallel processing model.) See also para. **[0049]**, discussing the TFC concept and the two “primary” types of transformations illustrated by reference numbers **330**, **350**, and para. **[0050]**, explaining the syntax in **Fig. 3**. Para. **[0052]** discusses the “TFC referencing” format shown in **Fig. 7**. The “<Transformation>” tag illustrated at **328, 329** in **Fig. 3** is discussed in more detail in paras. **[0053] - [0054]**, and the

“<Properties>” tag **335** and its child properties (which, as noted above in paragraph 27, specifies parameters for use when invoking executable code) are discussed in paras. **[0055] - [0058]**. The processing flow illustrated by **Fig. 6** is discussed in paras. **[0065] - [0068]**.

29. With regard to the supposed motivation to combine the references that is provided on p. 4, line 20 - p. 5, line 2 of the Office Action, Appellants respectfully submit that this motivation is flawed because it violates the holding of the Federal Circuit in *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), which stated that to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. Appellants submit that the supposed motivation to combine, stated in the Office Action as “since the combination would have provided many implementations as Hind disclosed”, is improper: Appellants are unable to find any discussions of this “many implementations” concept in Hind, and respectfully submit that such assertion in the Office Action is a “broad and conclusory statement” of the type forbidden by the holding in *In re Dembiczak*.

30. As noted above in paragraph 14, a proper §103 rejection requires that there be some suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; that there must be a reasonable expectation of success from such combination; and that the combination of references must teach or suggest all the claim limitations. As has been demonstrated above in paragraph 29, a proper motivation has not been provided. And as demonstrated above in paragraphs 16 - 28, the combination of references fails

to teach or suggest all of the claim limitations of independent Claim 1 – and in particular, neither reference, nor the combination, teaches use of a content file comprising a template that specifies a plurality of alternative selectable views (Claim 1, lines 4 - 6) and then using a particular one of the selected views within the content file (Claim 1, lines 11 - 12).

31. Furthermore, as stated above in paragraph 15, Appellants are entitled to have all words of their claim language considered. Paragraphs 16 - 28 and 30, above, demonstrate that Adams, Hind, and a combination thereof, do not teach, or suggest, all the limitations or all the words specified in independent Claim 1.

32. Accordingly, in view of paragraphs 16 - 31 herein, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of unpatentability as to independent Claim 1, and without more, thus claim is deemed patentable. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.

33. Independent Claim 18 specifies limitations similar to those of Claim 1 (as discussed above in paragraph 4), and is analyzed on p. 8, line 7 - p. 10, line 11 of the Office Action. The Office Action admits, on p. 10, line 4, that Adams does not “explicitly” disclose that the template is within the content source file. Page 10, lines 8 - 11 provide a supposed motivation for combining Adams and Hind that is identical to the motivation provided with regard to Claim 1. Refer to paragraphs 16 - 32, above, where the arguments presented therein apply in an analogous manner

to the claim language of independent Claim 18. In particular, refer to paragraphs 23 - 25, which demonstrate that Adams teaches away from specifying a template within a content file, in contrast to limitations in lines 4 - 8 of Appellants' Claim 18.

34. Accordingly, as demonstrated by paragraph 33 herein, Appellants' independent Claim 18 is deemed patentable over the references.

7.1.2) Rejection of Dependent Claims 2 - 4, 7 - 10, and 12

35. Dependent Claims 2 - 4, 7 - 10, and 12 stand or fall with independent Claim 1, from which they depend. Thus, these claims are deemed allowable by virtue of the allowability of independent Claim 1, the patentability of which is discussed above in "**7.1.1, Rejection of Independent Claims 1 and 18**".

7.1.3) Rejection of Dependent Claim 11

36. Page 7, lines 14 - 18 of the Office Action discuss dependent Claim 11 and cite **Fig. 5B** and col. 10, lines 14 - 19 of Adams as well as **Fig. 3** and 7 and paras. [0073] - [0074] of Hind.

37. By incorporation of independent Claim 1 from which it depends, dependent Claim 11 specifies that the selected alternative view is substituted, within the content file, "for the specification of the plurality ..." – in other words, substituted for the template that is (originally) within the content file. See Claim 1, lines 4 - 6 and lines 11 - 12; see also **310** of **Fig. 3**, illustrating a substitution using selected view **120** to replace the template **110** of **Fig. 1** (thereby

yielding document **300**).

38. By contrast, the cited text from col. 10, lines 14 - 19 of Adams indicates that content selected from one file (reference number **44a**, **44b**, or **44c** of **Fig. 5B**, in the example) is substituted for content **30** of separately-stored **Fig. 5A**. (See paragraph 18, above, where this two-file approach of Adams has been discussed.) This is not substitution within a content file, using an already-present alternative specified within that content file, in contrast to Appellants' claim language. Furthermore, in contrast to Appellants' claim language, Adams is not substituting anything for the template that specified the selectable alternatives; instead, content **30** (which is not a template, and which does not specify the selectable alternatives, in contrast to Appellants' claim language) is replaced by an alternative from the separately-stored file.

39. In contrast to Appellants' claim language, Hind also fails to teach this substitute-in-place approach using a selected alternative view that is selected from among a plurality of alternative views. See paragraphs 27 - 28, above, where differences between Hind and Appellants' claimed approach are discussed.

40. Accordingly, as demonstrated by paragraphs 36 - 39 herein, the Office Action fails to make out a *prima facie* case of unpatentability as to dependent Claim 11, and without more, this claim is deemed patentable.

41. Furthermore, Claim 11 is deemed patentable by virtue of the allowability of independent

Claim 1, from which it depends, the patentability of which is discussed above in “**7.1.1**,

Rejection of Independent Claims 1 and 18”.

7.2) Second Ground of Rejection

42. Paragraph 9 of the Office Action states that Claims 13 - 14, 16 - 17, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Adams in view of Hind and further in view of Narin. Of these claims, the independent claims are 13 and 19.

7.2.1) Rejection of Independent Claims 13 and 19

43. Independent Claim 13 specifies limitations similar to those of Claim 1 (as discussed above in paragraph 6), and is analyzed on p. 11, line 9 - p. 14, line 2 of the Office Action. The Office Action admits, on p. 13, lines 1 - 2, that Adams does not “explicitly” disclose that the template is within the content source file, in contrast to limitations specified in lines 4 - 7 of Claim 13. In fact, as noted above in paragraphs 23 - 24, Appellants respectfully submit that Adams teaches away from this claimed approach.

44. Limitations specified on lines 3 - 7 of Claim 13 are similar to those on lines 4 - 6 of Claim 1, and limitations specified on lines 8 - 9 of Claim 13 are identical to those on lines 7 - 8 of Claim 1. Limitations specified on lines 10 - 11 of Claim 13 are analogous to those on lines 11 - 13 of Claim 18, and limitations specified on lines 12 - 13 of Claim 13 are similar to those on lines 14 - 15 of Claim 18. Accordingly, refer to the discussion of Claim 1 in paragraphs 16 - 28 and 30 - 32, above, and the discussion of Claim 18 in paragraph 33 above, where it is demonstrated that

Adams, Hind, or a combination thereof fails to teach all limitations, including all of the words, of this claim language.

45. Furthermore, as noted above in paragraph 29, the supposed motivation provided on p. 13, lines 6 - 9 of the Office Action for combining Hind with Adams (which is identical to the motivation provided with regard to independent Claim 1) violates the holding in *In re Dembiczak*, and is therefore improper.

46. The Office Action cites Narin for teaching “determining that content should be generated from a particular template” (Office Action, p. 13, lines 19 - 21). Appellants respectfully submit that inclusion of Narin is moot, as none of the references (or any combination thereof) teaches the “template contained within a content file” that “specifies a plurality of alternative selectable views ...” (Claim 13, lines 4 - 7) and then using a particular one of the selected views when generating a version of the content (Claim 13, lines 12 - 13).

47. As noted above in paragraph 14, a proper §103 rejection requires that there be some suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; that there must be a reasonable expectation of success from such combination; and that the combination of references must teach or suggest all the claim limitations. As has been demonstrated above in paragraph 45, a proper motivation has not been provided. And as demonstrated above in paragraphs 43 - 44 and 46, the combination of references fails to teach or suggest all of the claim limitations of independent Claim 13.

48. Accordingly, in view of paragraphs 43 - 47 herein, Appellants respectfully submit that the Office Action fails to make out a *prima facie* case of unpatentability as to independent Claim 13, and without more, this claim is deemed patentable.

49. With regard to independent Claim 19, the Office Action states (p. 15, lines 1 - 3) that this claim is rejected under the same rationale used for rejecting Claim 13. Accordingly, by virtue of the arguments presented herein in paragraphs 43 - 48 with regard to Claim 13, Claim 19 is deemed patentable.

7.2.2) Rejection of Dependent Claims 14 and 16 - 17

50. Dependent Claims 14 and 16 - 17 stand or fall with independent Claim 13, from which they depend. Thus, these claims are deemed allowable by virtue of the allowability of Claim 13, the patentability of which is discussed above in “**7.2.1, Rejection of Independent Claims 13 and 19**”.

8) CONCLUSION

For the reasons set out above, Appellants respectfully contend that each appealed claim is patentable, and respectfully request that the Examiner’s Final Rejection of appealed Claims 1 - 4, 7 - 14, and 16 - 19 (as well as the rejection of dependent Claims 5 and 15) should be reversed.

Respectfully submitted,

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CLAIMS APPENDIX

CLAIMS AS CURRENTLY PRESENTED:

1 Claim 1: A computer-implemented method of selecting component-level views, comprising steps
2 of:
3 receiving, at a server-side device, a request for content;
4 locating a content file comprising a template for the requested content, wherein the
5 template specifies a plurality of alternative selectable views of a component that forms a portion
6 of the content and conditions under which each of the views should be selected;
7 evaluating one or more factors to determine an evaluation result, wherein the factors are
8 determined from the specified conditions;
9 using the determined evaluation result to select a particular one of the specified alternative
10 selectable views; and
11 using the particular one of the specified alternative views, within the content file, for the
12 portion of the content.

1 Claim 2: The method according to claim 1, wherein the request is received from a client-side
2 device and further comprising the step of returning a response to the client-side device, wherein
3 the response comprises the content file with the particular one of the alternative selectable views
4 incorporated therein.

1 Claim 3: The method according to claim 1, wherein the requested content is a particular Web
2 page and the template is a Web page template comprising syntax that defines a content portion of

3 the particular Web page.

1 Claim 4: The method according to claim 1, wherein the content file is a markup language
2 document.

1 Claim 5: The method according to claim 1, wherein the template is specified in a scripting
2 language and the content file is a markup language document.

Claim 6 (canceled)

1 Claim 7: The method according to claim 4, wherein each of the alternative selectable views is
2 specified as a child element of a particular parent element in the markup language document,
3 wherein each child element has, as a value, its associated alternative selectable view.

1 Claim 8: The method according to claim 1, wherein the template specifies alternative selectable
2 views for a plurality of components and conditions under which each of the views of each of the
3 components should be selected, and wherein the evaluating step and the steps of using the
4 determined evaluation result and using the particular one apply to each of the components.

1 Claim 9: The method according to claim 2, wherein the step of using the particular one further
2 comprises the step of omitting, from the content file, the specification of the alternative selectable
3 views which were not selected by the step of using the determined evaluation result.

1 Claim 10: The method according to claim 7, wherein the step of using the particular one further
2 comprises the step of omitting, from the content file, the particular parent element and the child
3 elements which were not selected by the step of using the determined evaluation result.

1 Claim 11: The method according to claim 1, wherein the step of using the particular one further
2 comprises the step of substituting the selected alternative view, within the content file, for the
3 specification of the plurality of alternative selectable views and conditions.

1 Claim 12: The method according to claim 3, wherein the step of using the particular one further
2 comprises the step of using the selected alternative view, within the content file, to generate a
3 version of the particular Web page wherein the content portion reflects the one or more evaluated
4 factors.

1 Claim 13: A computer-implemented method of generating content using alternative component-
2 level views, comprising steps of:

3 determining, at a server-side device, that content should be generated from a particular
4 template, wherein the template is contained within a content file for the content and specifies a
5 plurality of alternative selectable views of a component that forms a portion of the content,
6 conditions under which each of the views should be selected, and an associated selection identifier
7 for each of the specified alternative selectable views;

8 evaluating one or more factors to determine an evaluation result, wherein the factors are

9 determined from the specified conditions;
10 mapping the determined evaluation result to a particular one of the specified selection
11 identifiers, thereby selecting the associated one of the specified alternative selectable views; and
12 using, when generating a version of the content, the selected alternative view of the
13 component.

1 Claim 14: The method according to claim 13, further comprising the step of distributing the
2 generated version of the content to a client-side device.

1 Claim 15: The method according to claim 13, further comprising the step of storing the generated
2 version of the content in a repository.

1 Claim 16: The method according to claim 13, wherein the using step further comprises the step
2 of embedding the selected alternative view into the generated version of the content in place of
3 the specified plurality of alternative selectable views, conditions, and associated selection
4 identifiers.

1 Claim 17: The method according to claim 13, wherein the using step further comprises the step
2 of embedding an identifier of the selected alternative view into the generated version of the
3 content in place of the specified plurality of alternative selectable views, conditions, and
4 associated selection identifiers.

1 Claim 18: A system for selecting component-level views in a computing environment,
2 comprising:

3 means for receiving, at a server-side device, a client request for a particular Web page;

4 means for locating a content file comprising a template for the particular Web page,

5 responsive to operation of the means for receiving the client request, wherein the template

6 specifies a plurality of alternative selectable views of a component that forms a portion of the

7 particular Web page, conditions under which each of the views should be selected, and an

8 associated selection identifier for each of the specified alternative selectable views;

9 means for evaluating one or more factors to determine an evaluation result, wherein the
10 factors are determined from the specified conditions;

11 means for mapping the determined evaluation result to a particular one of the specified
12 selection identifiers, thereby selecting the associated one of the specified alternative selectable
13 views; and

14 using, when generating a version of the particular Web page, the selected alternative view
15 of the component in place of the specified plurality of alternative selectable views, the conditions,
16 and the associated selection identifiers .

1 Claim 19: A computer program product for generating content using alternative component-level
2 views, the computer program product embodied on one or more computer-readable media and
3 comprising:

4 computer-readable program code for determining, at a server-side device, that content
5 should be generated from a particular template, wherein the template specifies a plurality of

6 alternative selectable views of a component that forms a portion of the content and conditions
7 under which each of the views should be selected, and wherein the template is contained within a
8 content file for the content;

9 computer-readable program code for evaluating one or more factors to determine an
10 evaluation result, wherein the factors are determined from the specified conditions;

11 computer-readable program code for using the determined evaluation result to select a
12 particular one of the specified alternative selectable views; and

13 computer-readable program code for using the particular one of the alternative views,
14 within the content file in place of the specification of the alternative selectable views and the
15 conditions, for the component when generating a version of the content.

EVIDENCE APPENDIX

Appellants, the Appellants' legal representative, and the assignee have no personal knowledge of evidence requiring separate identification herein as bearing on this Appeal.

RELATED PROCEEDINGS APPENDIX

No related proceedings are personally known to Appellants, the Appellants' legal representative, or the assignee.